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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,464	02/04/2004	Yuji Hori	118554	1349
25944 7590 09/30/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
PELHAM, JOSEPH MOORE				
ART UNIT		PAPER NUMBER		
3742				
MAIL DATE		DELIVERY MODE		
09/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/770,464

Applicant(s)

HORI ET AL.

Examiner

Joseph M. Pelham

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/003)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The Examiner acknowledges the RCE amendment filed 9/12/08. Claims 1 and 3-9 remain pending.

Claim Rejections - 35 USC § 103

Claims 1, 3-6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. 4681423 in view of US Pat. Appl. 2003/0174355.

Referring to Fig. 5, 1:54-60 ("column:lines"), and 3:8-49, US'423 discloses a copier with a "first control processing" mode that initiates warm-up when placement of an original is detected.

US'423 does not disclose a "second control processing" mode that does not initiate a warm-up mode, but instead by a "copy operation instruction," a control unit that performs either the first or second "control processing" based on the mode set when the an original is detected (see par. [0064] *inter alia*).

Referring to paragraphs [0064]-[0070], US'355 discloses a "second control processing" mode – facsimile - that deactivates a warm-up mode, and initiates a "copy operation instruction" – a "normal mode, and the desired mode is set by the user before a "control processing" is executed." It would have been obvious to adapt the second mode of US'355, which deactivates the warm-up mode, to conserve energy during an outgoing facsimile transmission, when image fusing is not required. Since the determination of which of the processing modes is executed, when an original is detected, is determined by the mode set by the user beforehand, clearly US'355 alone discloses a "fixing unit [that] performs either one of the first... or second control processing based on the set operation mode when the original detection detects the set original," as claimed. A manual override (claim 9) simply retains the option to choose a mode at regardless of the automatic setting, which feature is virtually universal in diverse electronic devices. Claim 10 merely states that the mode executed is the mode set, which necessarily obtains in the operation of US'423 in view of US'355.

While US'423 does not explicitly disclose both manual and automatic mode selection (claim 5), the latter by detecting transmission, i.e. registering fax operation (claim 3), this does not patentably distinguish the claimed invention from the prior art. It would have been obvious to automatically disable the preheating mode during fax operation since preheating is then manifestly unnecessary. Claim 6 is met by control means that, when the device is turned on, retains the previous mode setting, which is conventional, and avoids the need to always select a mode when starting the device.

Allowable Subject Matter

Claims 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-5, 8 and 9 have been considered but are not persuasive.

Applicant, at pages 6 & 7 of the Remarks, has misconstrued the grounds of rejection, treating Nishijima in isolation and stating that Suehiro is applied "only for its alleged teaching of a second operating mode."

Suehiro, however, is applied for considerably more than its teaching of a second operating mode. Suehiro discloses two modes, one in which the device is preheated prior to any copy instruction (when "priority is given to the copy function," Par. [0064]), and the mode in which preheating is not desired because priority is given to the facsimile function (par. [0070]), i.e., that preheating is not desirable when the facsimile function is selected but is desirable when the copy function is selected. Nishijima teaches a type of copy function preheating which conserves energy.

The combination of Nishijima's preheat mode with Suehiro's plurality of functions associated with preheat and 'non-preheat' modes, clearly suggests a preheat mode when the copy function has priority (the claimed "first control processing" = Nishijima's warm-up in response to detection of an original) and a non-preheat mode when the facsimile function has priority (the claimed "second control processing" = Suehiro's "normal mode" of warm-up, started only when the copy instruction is issued).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph M. Pelham whose telephone number is 571-272-4786. The examiner can normally be reached on M-F 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.